



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/091,735 06/24/98 BRAMHILL

I 36-1230

EXAMINER

TM02/0717

NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201-4714

NGUYEN, D.

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED:

07/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/091,735

Applicant(s)

Bramhill et al.

Examiner

Cuong H. Nguyen

Art Unit

2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Apr 24, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above, claim(s) 9-11, 13, 19, 20, and 27 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 12, 14-18, 21-26, and 28-30 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). 9

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) Other:

Serial Number: 09/091,735
Art Unit: 2165

DETAILED ACTION

1. This Office Action is the answer to the amendment received on 6/20/2000; which paper has been placed of record.
2. Claims 1-30 are pending in this application; claims 9-11, 13, 19-20, and 27 have been canceled; claims 28-30 have been added.

Response:

3. Applicants' arguments received on 6/20/2000 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. § 103(a) rejections. All the answers to the arguments on pp.10-13 of the amendment received on 6/20/2000 are within court case decisions that the examiner submits as followings:

4. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998)), the court rules: "**The name of the game is the claim.**"
5. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims". See In re **Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have

Serial Number: 09/091,735
Art Unit: 2165

directed an artisan of ordinary skill to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

Motivation to Combine References (allegation of peace-meal limitations)

6. *In re Sheckler*, 168 USPQ 716 (CCPA 1971), the court ruled: It is **not necessary that a reference actually suggest changes or possible improvements which applicant made.**

7. *In re Fine*, 5 USPQ2d 1596 (CA FC 1988), the court ruled: The PTO can satisfy the burden under section 103 to establish a **prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."**

8. *In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967), the court ruled: "Although references do not disclose or

Serial Number: 09/091,735

Art Unit: 2165

suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they **do not teach or suggest exactly why this should be done**, other than to obtain the expected superior beneficial results."

9. *In re Beattie*, 24 USPQ2d 1040 (CA FC 1992), the court ruled: "Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, **despite absence of single express teaching of** marking system which combines two musical theories of prior art references, since law of **obviousness does not require that references be combined for reasons contemplated by inventor**, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

10. About argument of non-obviousness based on the number of references: *In re Gorman*, 18 USPQ2d 1885 (CA FC), the court ruled: "Patent and Trademark Office's reliance on teachings of large number of references in rejecting patent application for obviousness does not, without more, weigh against holding of

Serial Number: 09/091,735

Art Unit: 2165

obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field."

The examiner submits that base on *In re Hiniker*, the cited references became at least analogous/similar applications in data processing/computer/communication areas of their technique in achieving claimed results; and the examiner sees there is nothing inappropriate to cite these U.S. patents as references because they actually are related to claims' subject matters (see cited paragraphs, and US Classification for these references).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8, 12, 14-18, 21-26, and 28-30 are still rejected under 35 U.S.C. §103(a) as being unpatentable over Yourdon, in

Serial Number: 09/091,735

Art Unit: 2165

view of Dean et al., Wobber et al. (U.S. Pat. 5,235,642), and further in view of Richardson (PCT WO-A-9407204).

Yourdon suggests ideas of dealing about security on the Internet (see Yourdon pg. 28, cols.1-2 about **Security**), he submits that applications should ensure "secure access to functionality and data, as well as secure transmission of data across the Internet". Adding digital signatures to applets is contemplated, such that a user can be sure of the source and origin of a downloaded applets. As typical for a client server application, a password may be asked "to determine the end user's authorization to invoke certain functionalities of access certain data", and "the application will interact with the browser to encrypt/decrypt transmissions between the client and the server". He further proposes to integrate encryption packages like PGP into Internet applications and achieve higher security with a public key password system.

Dean et al. contribute ideas about security issues raised in Web browsers such as HotJava and Netscape by server supplied code constituted by Java applets downloaded to and run inside the Web browsers. "In Netscape, Java applets can name only those functions and variables explicitly exported to the Java

Serial Number: 09/091,735

Art Unit: 2165

subsystem". They further suggest that Java would be more secure if encryption was used.

Both Yourdon and Dean et al. talk about encryption, and hashing is known in the art as a similar security measure ensuring integrity of data. Yourdon also suggests hashing by proposing to add signatures to information downloaded from the Web such that the receiving side can be sure of its source and origin, thus of its integrity.

Both Yourdon and Dean et al. suggests method and systems for ensuring security of functionality and data in a client-server environment - in particular the Internet. However they do not directly address the specific problem of protecting from copying data, & authentication which have been downloaded from a server to a client, nor its solution as in claim 1.

Wobber et al. proposes to achieve access control using copies of clients credentials cached at the server for future use. The security system includes a computer at each node of the distributed system with a trusted computing base that includes an authentication agent for authenticating requests received from principals at other nodes in the system. Requests are transmitted to servers as messages that include a first identifier (i.e. Auth ID) provided by the requester and a second

Serial Number: 09/091,735
Art Unit: 2165

identifier (called the subchannel value) provided by the requester and a second identifier (called the subchannel value) provided by the authentication agent of the requester node. Each server process has an associated local cache that identifies requesters whose previous request messages have been authenticated. When a request is received, the server checks the request's two identifiers against the entries in its local cache. If there is a match, the request is known to be authentic without having to obtain authentication from the requester's node.

Nevertheless, it is held that one with skills in the art would need no inventive activity to infer from the general teachings of Yourdon ("to determine the end user's authorization to invoke certain functionalities of access certain data", and Dean et al. ("applets can name only those functions and variables explicitly exported to the Java sub-system", at least when taken in combination, that a solution consists in selectively controlling copying functions of the client in respect of the downloaded data, hence arriving at the subject matter of claim 1.

12. As per claims 5-6, 17: Yourdon, Richardson, and Wobber et al. also teaches about password, public key, password system that claimed (in claims 5, 6, 17). Therefore, the same reasoning

Serial Number: 09/091,735
Art Unit: 2165

applies for identifying/authorizing/registering a client to a server.

13. As per claims 7-8: Gosling (EP 0718761 A1) also discloses the downloading of a program. This feature is well-known in the art.

14. As per claims 12-16: Bender et al. also disclose about steganographically marking data (claim 16); this feature is also well-known in the art. The Official Notice is taken that the feature of claims 12, and the use of a cryptographic key are well-known in the art.

Conclusion

15. Claims 1-8, 12, 14-18, 21--26, 28-30 are rejected.

16. The prior submitted references are considered pertinent to applicants' disclosure.

17. Remarks:

A. About making a component "portable":

In re **Lindberg**, 93 USPQ 23 (CCPA 1952), the court said: Moreover, even if this feature were properly recited in the appealed claims, as pointed out by the Solicitor of the Patent Office in his brief, this in itself would not render the claims patentable since it is not regarded as inventive to merely make an old device portable or movable without producing any new and

Serial Number: 09/091,735
Art Unit: 2165

unexpected result. See **Rance, Inc. v. Gwynn et al.**, 128 F. 2d 437 (54 USPQ 3).

B. In re Keller, Terry, and Davies, 208 USPO 871 (CCPA 1981)

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

C. Ex parte Rubin, 5 USPO2d 1461 (BdPatApp&Int 1987):

Knowledge in the art may have advanced such that results considered incredible are no longer *per se* incredible.

D. In re Susi, 169 USPO 423 (CCPA 1971): Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

E. In re Heck, 216 USPO 1038 (Fed. Cir. 1983): "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which

• Serial Number: 09/091,735
Art Unit: 2165

they are concerned. They are part of the literature of the art, relevant for all they contain."

F. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); in this application, it is so obvious to one with skills in the art to apply these limitations in a condition of non-networked accessing).

G. About carrying forward another's invention--Design choice to make integral:

In re Larson, 144 USPQ 347 (CCPA 1965), the court said: "While the brake disc and clamp of Tuttle et al. comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole. Webster's New International Dictionary (2nd edition) defines "integral" as "(2) composed of constituent parts making a whole; composite; integrated." We are inclined to agree with the board's construction of the term "integral" as used in claim 12. Then, too, we are inclined to agree with the position of the solicitor that the use of a one piece construction instead of the

• Serial Number: 09/091,735
Art Unit: 2165

structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice. In re **Fridolph**, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319; and in re Lockhart, 90 USPQ 214 (CCPA 1951) the court said: After a careful examination of the record, we do not find ourselves in agreement with appellant's argument. Although it is true that invention may be present under some circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a requirement that the unification or integration involve more than mere mechanical skill. In re **Murray**, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; In re **Zabel et al.**, 38 CCPA 832, 186 F.2d 735, 88 USPQ 367. In this case, all of the essential elements of the appealed claims except integration of parts, are found in the references. It appears to us that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the syringe, than on any inventive concept.

and in Howard v. Detroit Stove Works, 150 US 164 (CCPA 1893), the court said: "As to the 3rd patent, it is void because the claims in it were clearly anticipated, and because it involves no

- Serial Number: 09/091,735
Art Unit: 2165

invention to cast in one piece an article which has formerly been cast in two pieces and put together, nor to make the shape of the grate correspond with that of the firepot".

H. MPEP 2113 Product-by-Process Claims:

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

I. The functions perform on this apparatus/system needs internal dedicated software that allows it to store, organize, retrieve, and transfer .. .etc., as computers cannot perform storage and retrieval functions without software. Any retrieval and storage function by computers would necessitate dedicated software, which the application does not disclose.

K. The examiner submits that the reasons for rejection are inherent and obvious v.s. cited prior arts. One of ordinary skills in the art at the time of the invention would have found these claim's limitations would be very obvious with inherent

Serial Number: 09/091,735
Art Unit: 2165

steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior arts are also directed to a similar process for obtaining job applications from remotely located applicants. These prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited inventions have been described in connection with specific preferred embodiments, it should be understood that invention as claimed should not be unduly limited to such specific embodiments

L. The examiner submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:30 PM.

Serial Number: 09/091,735
Art Unit: 2165

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on (703) 308-1344.

Any response to this action should be mailed to:

Amendments
Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications
intended for entry)

Or: (703) 305-0040/308-5397 (for informal or draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of
this application should be directed to the Group receptionist
whose telephone number is (703) 305-3900.



Cuong H. Nguyen
Patent Examiner
July 13, 2001